



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/850,041	05/07/2001	Attila Lorincz	2629-4023	1436

7590

09/09/2002

MORGAN & FINNEGAN, L.L.P.
345 Park Avenue
New York, NY 10154-0053

EXAMINER

MYERS, CARLA J

ART UNIT	PAPER NUMBER
----------	--------------

1634

DATE MAILED: 09/09/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/850,041

Applicant(s)

LORINCZ ET AL.

Examiner

Carla Myers

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 August 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: _____

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____


CARLA J. MYERS
PRIMARY EXAMINER

Continuation of 3. Applicant's reply has overcome the following rejection(s): the terminal disclaimer filed August 16, 2002, disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent 6,228,578 has been reviewed and is accepted. The terminal disclaimer has been recorded. The terminal disclaimer overcomes the previous obviousness-type double patenting rejection. The response further overcomes the previous rejection of claims 43-45 under 35 USC 112, second paragraph .

Continuation of 5. does NOT place the application in condition for allowance: In summary, the rejection of claim 33 under 112 first paragraph (new matter) and under 35 USC 112 second paragraph over the recitation of "unmodified probe" is maintained. Applicants argument that one of skill in the art would know that this phrase refers to probes which comprise nucleic acids which are chemically and structurally unmodified is not convincing because a definition for this phrase is not provided in the specification and Applicants have not provided any evidence that this phrase has a well known and fixed definition in the art . Further, with respect to the 112 first rejection, it is not only an issue of whether the term is known in the art, but also an issue of whether the specification as originally filed provides basis for the concept of unmodified probes. While the specification as originally filed teaches the use of labeled and unlabeled probes, the specification does not discuss the concept of modifying probes and does not disclose the specific embodiment of using unmodified probes. With respect to the rejections under 35 U.S.C. 103, Applicants arguments that Rashtchian does not teach unmodified probes is not convincing because the biotinylated probes of Rashtchian are considered to be unmodified probes. Applicants claims are not limited to unlabeled probes and since there is no definition in the specification or in the art as to what constitutes an unmodified probe, unmodified probes are considered to include probes carrying a label. Again, Applicants are requested to provide a citation in the art which clearly sets forth a well accepted definition for the phrase "unmodified probes" or a teaching within the specification setting forth such a definition for "unmodified probes", wherein such a definition specifically excludes probes that are labeled. Applicants further argue that Carrico uses a modified probe because the probe of Carrico is immobilized onto a solid support or has the ability to be immobilized onto a solid support. This argument is not convincing because Applicants have not provided any evidence to show that the phrase "unmodified probes" excludes probes which are immobilized. Further the fact that the probes of Carrico may be immobilized does not imply that the probes are modified. As taught by Carrico, probes may be immobilized through binding to a binding partner, such as a promoter or operator sequence binding to a protein (column 8). There is also no need to modify in any manner a probe which is to be immobilized in this manner. Carrico also teaches that probes may be directly immobilized via adsorption (column 7). Accordingly, the probes of Carrico which are in an "immobilizable form" are also considered to be unmodified.